UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/435,504	11/06/1999	DENNIS SUNGA FERNANDEZ	FERN-P006	5319

22877 7590 03/14/2003

FERNANDEZ & ASSOCIATES LLP
1047 EL CAMINO REAL
SUITE 201
MENLO PARK, CA 94025

EXAMINER	
MORGAN, ROBERT W	
ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/435,504	FERNANDEZ, DENNIS SUNGA	
	Examiner	Art Unit	
	Robert W. Morgan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/26/02 and 1/6/03* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 21-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 21-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. In the amendment filed 11/26/02 and supplemental amendment filed 1/6/03 papers number 10 and 12 respectively, the following has occurred: Claims 21-28 have been added. Claim 1 has been amended twice and Claims 8, 21, 23, 26, 27 and 28 have been amended. Claims 13-20 have been canceled. Now claims 1-12 and 21-28 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 5, 7, 8, 11, 12, 21-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,366,682 to Hoffman et al. in view of U.S. Patent No. 6,275,824 to O'Flaherty et al.

As per claim 1, Hoffman et al. teaches a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer system by submitting a PIN, at least one registration biometric sample (reads on "personal genetic nucleotide profile") and at least one financial account (see: column 4, lines 18-24). During the transmission step, when a buyer accepts a seller proposal (transaction), the computer system compares the bid biometric sample with the registered biometric samples for producing either a successful or failed identification of the buyer (reads on "automated transaction method via a processor used for evaluating a user transaction"). In another embodiment, Hoffman et al. teaches an increase to

provide assurance of accurate identification by comparing a buyer's biometric from among a basket of other biometric, the basket being a subset of all stored biometrics in the system (reads on "user permitting a portion of a personal genetic profile being associated or used with evaluating the user transaction") (see: column 5, lines 60-64).

Hoffman et al. fails to teach a bioinformatic value automatically determined when or after the user permits access to a voluntarily-selected portion of his or her personal genetic nucleotide profile, such accessible portion being associated or used with evaluating the user transaction via a processor, an other portion of such genetic profile being not voluntarily-selected by the user and thereby inaccessible for evaluating the user transaction.

O'Flaherty et al. teaches system and method for managing data privacy in a database management system that allows the storing of one or more characters ("A" or "D") or flags (represented by "1s" and "0s") which specify privacy preferences for the consumer's data records. These privacy preferences include "opt-outs" for (1) direct marketing, (2) disclosure of personal data along with information identifying the consumer, (3) anonymous disclosure of personal data, (4) disclosure of personal data for purposes of making automated decisions, and (5) disclosure or use of sensitive data (see: column 7, lines 10-35). The customer table (202, Fig. 3A) also comprises a global data control column (210, Fig. 3A). If a consumer permitted some data collection, analysis, or dissemination by selecting a "0" in the global data control column (210, Fig. 3A). The customers has indicated that his information can be disclosed to a third parties, both with his identity, and anonymously and has allowed the data to be used to perform automated processing, and will permit the dissemination of sensitive data (see: column 7, lines

10-35 and Fig. 3A-3C) (reads on "other portion of profile information being not voluntarily-selected by the user and thereby inaccessible for evaluating the user transaction").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the privacy preference including "opts-outs" as taught by O'Flaherty et al. within the tokenless electronic transaction system using biometric samples as taught by Hoffman et al. with the motivation of protecting the rights of individuals regarding data abuse by those in control of an individual's stored information (see: column 2, lines 41-47).

As per claim 5, O'Flaherty et al. teaches system and method for managing data privacy in a database management system that allows the storing of one or more characters ("A" or "D") or flags (represented by "1s" and "0s") which specify privacy preferences for the consumer's data records. These privacy preferences include "opt-outs" for (1) direct marketing, (2) disclosure of personal data along with information identifying the consumer, (3) anonymous disclosure of personal data, (4) disclosure of personal data for purposes of making automated decisions, and (5) disclosure or use of sensitive data (see: column 7, lines 10-35). The customer table (202, Fig. 3A) also comprises a global data control column (210, Fig. 3A). If a consumer permitted some data collection, analysis, or dissemination by selecting a "0" in the global data control column (210, Fig. 3A). The customers has indicated that his information can be disclosed to a third parties, both with his identity, and anonymously and also has allowed the data to be used to perform automated processing, and will permit the dissemination of sensitive data (see: column 7, lines 10-35 and Fig. 3A-3C) (reads on "user-authorized mask").

As per claim 7, Hoffman et al. and O'Flaherty et al. teach a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer

system by submitting a PIN, at least one registration biometric sample and at least one financial account (see: Hoffman: column 4, lines 18-24). Hoffman et al. and O'Flaherty et al. teaches system and method for managing data privacy in a database management system that allows the storing of one or more characters ("A" or "D") or flags (represented by "1s" and "0s") which specify privacy preferences for the consumer's data records (see: O'Flaherty et al: column 7, lines 10-35).

As per claim 8, Hoffman et al. and O'Flaherty et al. teach a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer system by submitting a PIN, at least one registration biometric sample and at least one financial account (see: Hoffman: column 4, lines 18-24). During the transmission step, when a buyer accepts a seller proposal (transaction), the computer system compares the bid biometric sample with the registered biometric samples for producing either a successful or failed identification of the buyer (see: column 5, lines 60-64). In another embodiment, Hoffman et al. and O'Flaherty et al. teach an increase to provide assurance of accurate identification by comparing a buyer's biometric from among a basket of other biometric, the basket being a subset of all stored biometrics in the system (see: Hoffman: column 5, lines 60-64). Hoffman et al. and O'Flaherty et al. teach a system and method for managing data privacy in a database management system that allows the storing of one or more characters ("A" or "D") or flags (represented by "1s" and "0s") which specify privacy preferences for the consumer's data records (see: O'Flaherty: column 7, lines 10-35).

As per claims 11 and 12, Hoffman et al. teaches a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer system by

submitting a PIN, at least one registration biometric sample and at least one financial account (see: column 4, lines 18-24). During the transmission step, when a buyer accepts a seller proposal (transaction), the computer system compares the bid biometric sample with the registered biometric samples for producing either a successful or failed identification of the buyer (see: column 4, lines 33-39). In another embodiment, Hoffman et al. teaches an increase to provide assurance of accurate identification by comparing a buyer's biometric from among a basket of other biometric, the basket being a subset of all stored biometrics in the system (see: column 5, lines 60-64). Hoffman et al. further teaches that each Data Processing Center (DPC) is made up of a number of computers and databases connected over a LAN or network (13, Fig. 1) (see: Hoffman: column 18, lines 51-52 and Fig. 2). In addition, Hoffman et al. teaches a terminal (2, Fig. 3) and the biometric input device (12, Fig. 3), which has biometric scanner (13, Fig. 3) (see: Hoffman: column 9, lines 27-29).

As per claim 21, Hoffman et al. teaches that to increase assurance of accurate identification a buyer's biometric is compared from a basket of other biometric, the basket being a subset of all stored biometrics in the system (see: column 5, lines 60-64).

As per claim 22, Hoffman et al. teaches a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer system by submitting a PIN, at least one registration biometric sample and at least one financial account (see: column 4, lines 18-24). During the transmission step, when a buyer accepts a seller proposal (transaction), the computer system compares the bid biometric sample with the registered biometric samples for producing either a successful or failed identification of the buyer (see: column 4, lines 33-39).

As per claim 23, Hoffman et al. teaches a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer system by submitting a PIN, at least one registration biometric sample and at least one financial account (see: column 4, lines 18-24). During the transmission step, when a buyer accepts a seller proposal (transaction), the computer system compares the bid biometric sample with the registered biometric samples for producing either a successful or failed identification of the buyer (see: column 4, lines 33-39). In addition, Hoffman teaches that in order to protect against fraud a buyer during the registration step selects a private code in addition to biometric, PIN, financial accounts and index codes (see column 5, lines 1-8).

As per claim 24, Hoffman et al. teaches a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer system by submitting a PIN, at least one registration biometric sample and at least one financial account (see: column 4, lines 18-24). During the transmission step, when a buyer accepts a seller proposal (transaction), the computer system compares the bid biometric sample with the registered biometric samples for producing either a successful or failed identification of the buyer (see: column 4, lines 33-39). Hoffman et al. further teaches a buyer identification procedure including messages regarding status codes (OK, failed, silent alarm) (see: column 22, lines 50 to column 23, lines 20).

As per claim 25, Hoffman et al. teaches the use of terminals (2, Fig. 3) and the biometric input device (12, Fig. 3), which has biometric scanner (13, Fig. 3) (see: column 9, lines 27-29).

As per claim 27, Hoffman et al. teaches a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer system by submitting a PIN, at least one registration biometric sample (reads on "personal genetic nucleotide profile") and at

least one financial account (see: column 4, lines 18-24). During the transmission step, when a buyer accepts a seller proposal (transaction), the computer system compares the bid biometric sample with the registered biometric samples for producing either a successful or failed identification of the buyer (reads on "automated transaction method via a processor used for evaluating a user transaction"). In another embodiment, Hoffman et al. teaches an increase to provide assurance of accurate identification by comparing a buyer's biometric from among a basket of other biometric, the basket being a subset of all stored biometrics in the system (reads on "user permitting a portion of a personal genetic profile being associated or used with evaluating the user transaction") (see: column 5, lines 60-64).

Hoffman et al. fails to teach a bioinformatic value automatically determined when or after the user permits access to a voluntarily-selected portion of his or her personal genetic nucleotide profile, such accessible portion being associated or used with evaluating the user transaction via a processor, an other portion of such genetic profile being not voluntarily-selected by the user and thereby inaccessible for evaluating the user transaction.

O'Flaherty et al. teaches system and method for managing data privacy in a database management system that allows the storing of one or more characters ("A" or "D") or flags (represented by "1s" and "0s") which specify privacy preferences for the consumer's data records. These privacy preferences include "opt-outs" for (1) direct marketing, (2) disclosure of personal data along with information identifying the consumer, (3) anonymous disclosure of personal data, (4) disclosure of personal data for purposes of making automated decisions, and (5) disclosure or use of sensitive data (see: column 7, lines 10-35). The customer table (202, Fig. 3A) also comprises a global data control column (210, Fig. 3A). If a consumer permitted some

data collection, analysis, or dissemination by selecting a "0" in the global data control column (210, Fig. 3A). The customers has indicated that his information can be disclosed to a third parties, both with his identity, and anonymously and has allowed the data to be used to perform automated processing, and will permit the dissemination of sensitive data (see: column 7, lines 10-35 and Fig. 3A-3C) (reads on "other portion of profile information being not voluntarily-selected by the user and thereby inaccessible for evaluating the user transaction").

The obviousness for combining the teaching of O'Flaherty in the system as taught by Hoffman et al. is discussed in the rejection of claim 1, and incorporated herein.

4. Claims 2-4, 6, 9, 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,366,682 to Hoffman et al. in view of U.S. Patent No. 6,275,824 to O'Flaherty et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,876,926 to Beecham.

As per claims 2-4, Hoffman et al. and O'Flaherty et al. fail to teach bioinformatic value comprising a likelihood or risk of the user having or developing a genetically-based mental or physiological or emotional condition, wherein the transaction step comprises providing the user with an insurance policy, service contract and promotional offer or bid to serve the genetically-based condition.

Beecham teaches a method and apparatus for collecting sample from a test subject and taking the biometric data from the test subject (see: abstract). Beecham further teaches that genetic testing; for example, laboratory testing for genetic markers of disease and hereditary susceptibility to diseases or specific conditions is a rapidly developing area of medicine. Current methods include DNA and RNA analysis based on hybridization techniques such as fluorescence

in situ hybridization, restriction length polymorphism and polymerase chain reaction for amplification of nucleic acid (see: column 5, lines 27-34). Furthermore, diseases and hereditary predispositions to disease for which genetic testing is currently available include sickle cell anemia, muscular dystrophy of various types, fragile X disease, chronic myelogenous leukemia, predisposition to development of cancer such as breast cancer gene BRCA-1 or colon cancer gene. These issues have had considerable public attention focused on them because they may be used to discriminate against some people in specific settings, e.g., in the making of hiring and downsizing decisions, in permitting the individual to obtain health insurance and the likes (see: column 5, lines 35-44). Moreover, some people fear that if genetic test results were made available or seized from a doctor, discrimination may occur against individuals with genetic predisposition to disease. Governmental and private concern for implications of a positive genetic test result, as for example for BRCA1, is well known. For further example, President Clinton indicated recently that a law would be proposed that makes it illegal for an insurance company to restrict coverage where a person has a genetic test result indicating possible future disease is likely (see: column 18, lines 30-45).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include the testing of biometric data for genetic markers of disease and hereditary susceptibility to diseases or specific conditions as taught by Beecham within the system as taught by Hoffman et al. and O'Flaherty et al. with the motivation of preventing discrimination against people in the workplace and obtaining health insurance (see: column 5, lines 40-45).

As per claim 6, Hoffman et al. and O'Flaherty et al. teach a system and method for managing data privacy in a database management system that allows the storing of one or more

characters ("A" or "D") or flags (represented by "1s" and "0s") which specify privacy preferences for the consumer's data records. These privacy preferences include "opt-outs" for (1) direct marketing, (2) disclosure of personal data along with information identifying the consumer, (3) anonymous disclosure of personal data, (4) disclosure of personal data for purposes of making automated decisions, and (5) disclosure or use of sensitive data (see: column 7, lines 10-35). The customer table (202, Fig. 3A) also comprises a global data control column (210, Fig. 3A). If a consumer permitted some data collection, analysis, or dissemination by selecting a "0" in the global data control column (210, Fig. 3A). The customers has indicated that his information can be disclosed to a third parties, both with his identity, and anonymously and also has allowed the data to be used to perform automated processing, and will permit the dissemination of sensitive data (see: O'Flaherty: column 7, lines 10-35 and Fig. 3A-3C).

Hoffman et al. and O'Flaherty et al. fails to teach bioinformatic value comprising a likelihood or risk of the user having or developing a genetically-based condition based on a statistical or actuarial table and a genetic or heredity profile associated with the user.

Beecham teaches a method and apparatus for collecting sample from a test subject and taking the biometric data from the test subject (see: abstract). Beecham further teaches that genetic testing; for example, laboratory testing for genetic markers of disease and hereditary susceptibility to diseases or specific conditions is a rapidly developing area of medicine. Current methods include DNA and RNA analysis based on hybridization techniques such as fluorescence in situ hybridization, restriction length polymorphism and polymerase chain reaction for amplification of nucleic acid (see: column 5, lines 27-34). Furthermore, diseases and hereditary predispositions to disease for which genetic testing is currently available include sickle cell

anemia, muscular dystrophy of various types, fragile X disease, chronic myelogenous leukemia, predisposition to development of cancer such as breast cancer gene BRCA-1 or colon cancer gene. These issues have had considerable public attention focused on them because they may be used to discriminate against some people in specific settings, e.g., in the making of hiring and downsizing decisions, in permitting the individual to obtain health insurance and the likes (see: column 5, lines 35-44). Moreover, some people fear that if genetic test results were made available or seized from a doctor, discrimination may occur against individuals with genetic predisposition to disease. Governmental and private concern for implications of a positive genetic test result, as for example for BRCA1, is well known. For further example, President Clinton indicated recently that a law would be proposed that makes it illegal for an insurance company to restrict coverage where a person has a genetic test result indicating possible future disease is likely (see: column 18, lines 30-45).

The obviousness for combining the teaching of Beecham with the system as taught by Hoffman et al. and O'Flaherty et al. are discussed in the rejection of claim 2, and incorporated herein.

As per claim 9, Hoffman et al. and O'Flaherty et al. fail to teach a bioinformatic value comprises an increase or decrease of likelihood or risk of the user having or developing the genetically-based condition.

Beecham teaches a method and apparatus for collecting sample from a test subject and taking the biometric data from the test subject (see: abstract). Beecham further teaches that genetic testing; for example, laboratory testing for genetic markers of disease and hereditary susceptibility to diseases or specific conditions is a rapidly developing area of medicine. Current

methods include DNA and RNA analysis based on hybridization techniques such as fluorescence in situ hybridization, restriction length polymorphism and polymerase chain reaction for amplification of nucleic acid (see: column 5, lines 27-34). Furthermore, diseases and hereditary predispositions to disease for which genetic testing is currently available include sickle cell anemia, muscular dystrophy of various types, fragile X disease, chronic myelogenous leukemia, predisposition to development of cancer such as breast cancer gene BRCA-1 or colon cancer gene. These issues have had considerable public attention focused on them because they may be used to discriminate against some people in specific settings, e.g., in the making of hiring and downsizing decisions, in permitting the individual to obtain health insurance and the likes (see: column 5, lines 35-44).

The obviousness for combining the teaching of Beecham with the system as taught by Hoffman et al. and O'Flaherty et al. are discussed in the rejection of claim 2, and incorporated herein.

As per claim 10, Hoffman et al. and O'Flaherty et al. teach a method and system for tokenless authorization of commercial transactions where a buyer registers with a computer system by submitting a PIN, at least one registration biometric sample and at least one financial account (see: Hoffman: column 4, lines 18-24). Hoffman et al. and O'Flaherty et al. further teach that each Data Processing Center (DPC) is made up of a number of computers and databases connected over a LAN or network (13, Fig. 1) (see: Hoffman: column 18, lines 51-52 and Fig. 2). In addition, Hoffman et al. and O'Flaherty et al. teach a terminal (2, Fig. 3) and the biometric input device (12, Fig. 3), which has biometric scanner (13, Fig. 3) (see: Hoffman: column 9, lines 27-29).

Hoffman et al. and O'Flaherty et al. fails to teach bioinformatic value used for transacting remotely with the user for enabling a medical service for the user.

Beecham teaches a method and apparatus for collecting sample from a test subject and taking the biometric data from the test subject (see: abstract). Beecham further teaches that genetic testing, for example, laboratory testing for genetic markers of disease and hereditary susceptibility to diseases or specific conditions is a rapidly developing area of medicine (see: column 5, lines 27-34). Beecham also teaches that President Clinton indicated recently that a law would be proposed that makes it illegal for an insurance company to restrict coverage where a person has a genetic test result indicating possible future disease is likely (see: column 18, lines 30-45).

The obviousness for combining the teaching of Beecham with the system as taught by Hoffman et al. and O'Flaherty et al. are discussed in the rejection of claim 2, and incorporated herein.

As per claim 28, Hoffman et al. and O'Flaherty et al. teach a system and method for managing data privacy in a database management system that allows the storing of one or more characters ("A" or "D") or flags (represented by "1s" and "0s") which specify privacy preferences for the consumer's data records. These privacy preferences include "opt-outs" for (1) direct marketing, (2) disclosure of personal data along with information identifying the consumer, (3) anonymous disclosure of personal data, (4) disclosure of personal data for purposes of making automated decisions, and (5) disclosure or use of sensitive data (see: column 7, lines 10-35). The customer table (202, Fig. 3A) also comprises a global data control column (210, Fig. 3A). If a consumer permitted some data collection, analysis, or dissemination by

selecting a "0" in the global data control column (210, Fig. 3A). The customers has indicated that his information can be disclosed to a third parties, both with his identity, and anonymously and also has allowed the data to be used to perform automated processing, and will permit the dissemination of sensitive data (see: O'Flaherty: column 7, lines 10-35 and Fig. 3A-3C).

Hoffman et al. and O'Flaherty et al. fail to teach transacting with the user a healthcare service according to the determined bioinformatic value.

Beecham teaches a method and apparatus for collecting sample from a test subject and taking the biometric data from the test subject (see: abstract). Beecham further teaches that genetic testing; for example, laboratory testing for genetic markers of disease and hereditary susceptibility to diseases or specific conditions is a rapidly developing area of medicine. Current methods include DNA and RNA analysis based on hybridization techniques such as fluorescence in situ hybridization, restriction length polymorphism and polymerase chain reaction for amplification of nucleic acid (see: column 5, lines 27-34). Furthermore, diseases and hereditary predispositions to disease for which genetic testing is currently available include sickle cell anemia, muscular dystrophy of various types, fragile X disease, chronic myelogenous leukemia, predisposition to development of cancer such as breast cancer gene BRCA-1 or colon cancer gene. These issues have had considerable public attention focused on them because they may be used to discriminate against some people in specific settings, e.g., in the making of hiring and downsizing decisions, in permitting the individual to obtain health insurance and the likes (see: column 5, lines 35-44). Moreover, some people fear that if genetic test results were made available or seized from a doctor, discrimination may occur against individuals with genetic predisposition to disease. Governmental and private concern for implications of a positive

genetic test result, as for example for BRCA1, is well known. For further example, President Clinton indicated recently that a law would be proposed that makes it illegal for an insurance company to restrict coverage where a person has a genetic test result indicating possible future disease is likely (see: column 18, lines 30-45).

The obviousness for combining the teaching of Beecham with the system as taught by Hoffman et al. and O'Flaherty et al. are discussed in the rejection of claim 2, and incorporated herein.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,366,682 to Hoffman et al. in view of U.S. Patent No. 6,275,824 to O'Flaherty et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,876,926 to Beecham and U.S. Patent No. 6,389,428 to Rigault et al.

As per claim 26, Hoffman et al., O'Flaherty et al. and Beecham teach a method and apparatus for collecting sample from a test subject and taking the biometric data from the test subject (see: Beecham: abstract). Hoffman et al., O'Flaherty et al. and Beecham teach further teaches that genetic testing, for example, laboratory testing for genetic markers of disease and hereditary susceptibility to diseases or specific conditions is a rapidly developing area of medicine. Current methods include DNA and RNA analysis based on hybridization techniques such as fluorescence in situ hybridization, restriction length polymorphism and polymerase chain reaction for amplification of nucleic acid (see: Beecham: column 5, lines 27-34).

Hoffman et al., O'Flaherty et al. and Beecham teach fail to teach a genetic nucleotide profile corresponding to a single nucleotide polymorphism (SNP) associated with the user.

Rigault et al. teaches a computer system that stores biomolecular data such as full length mRNA sequences, genomic sequences, synthetic sequences, peptide sequences, polypeptide sequences, peptide nucleic acid sequences, and genome mapping, pharmacogenomic, proteomic, single nucleotide polymorphism, genotyping and forensic data in a database (see: abstract and column 17, lines 10-66).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include using single nucleotide polymorphism as taught by Rigault et al. with system as taught by Hoffman et al., O'Flaherty et al. and Beecham with the motivation of providing a way to store and associate mapping information with clones and clusters (see: Rigault et al.: column 17, lines 25-26).

Response to Arguments

Applicant's arguments with respect to claims 1-13 and 21-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In related art (5,187,775) Schroeder et al. teaches a display system with a digital computer designed for displaying information about nucleotide sequences such as DNA sequences and the protein or amino acid sequences associated with those nucleotide sequences.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

rwm
March 9, 2003

DINH X. NGUYEN
PRIMARY EXAMINER